



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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9-21-01

In re application of:

Paul FREDERICK

Appl. No. 09/452,952

Filed: December 2, 1999

For: METHOD FOR DISTRIBUTING
SPORTS ENTERTAINMENT

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Technology Center 2600

Art Unit: 2613

Examiner: A. Wong

Atty. Docket No.: 36722-161778

Customer No.



26694

PATENT TRADEMARK OFFICE

APPEAL BRIEF

Assistant Commissioner for Patents
Washington, D.C. 22031

Sir:

This is an appeal to the Board of Patent Appeals and Interferences from the decision in the Office Action mailed April 6, 2001. A Notice of Appeal was filed on July 11, 2001.

(1) REAL PARTY OF INTEREST

The Applicant is the real party of interest in this appeal.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

(3) STATUS OF CLAIMS

09/19/2001 SLUANG1 00000014 09452952

02 FC:215

55.00 OP

The claims involved in this appeal are set forth in the Appendix to this Brief.

Claims 1-14 have been finally rejected and are being appealed.

09/19/2001 SLUANG1 00000014 09452952
01 FC:220
155.00 OP

(4) STATUS OF AMENDMENTS

No Amendments After Final have been filed.

(5) SUMMARY OF THE INVENTION

The present invention relates to a method for distributing video images of a racing event. Each of the participants of the event is provided with a video camera to generate a feed reflecting the perspective from each of the participants. The feeds are transmitted to retransmission equipment for receiving the information and directing the information regarding the video images to respective channels for remote viewing at viewers' locations. Each of the plurality of viewers is allowed to select from the plurality of the channels to thus enable viewing of the event through the perspective of one or more participants of greatest interest to the particular viewer.

The video cameras can be provided with microphones to provide audio information that accompanies the video information and is selectively receivable by viewers. A pay-per-view television or internet system can be provided to transmit the video signal. A combination of camera feeds can be displayed as a plurality of resulting images on a split television or monitor screen. The provider of the images can add advertising to the video information. The provider can also keep track to the viewers' request for the camera feed of the sporting event as a function of the participants of interest and can use the information to help satisfy viewer interest, compensate participants, and price advertising opportunities. A camera feed can be generated for all the participants or just a select group determined by the number of viewer requests. The

viewer can select a camera feed for a particular team or the predicted winners of the events.

(6) ISSUES

The following issues are presented to the Board:

Whether claims 1, 4-6, 10 and 12-14 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Matthews, and
Whether claims 2, 3, and 7-9 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over Matthews in view of Vancelette.

(7) GROUPING OF CLAIMS

The claims are grouped as follows:

Group I - Claims 1, 13, and 14;

Group II - Claims 7 and 8; and

Group III-XI - Claims 2-6 and 9-12, individually representing respective groups.

It is respectfully submitted that the above groups of claims are separately patentable and do not stand or fall together. The reason for this is that, while the arguments applicable to Group I are also applicable to Groups II-XI, there are additional arguments in favor of the patentability for each of Groups II-XI.

(8) ARGUMENT

The first sentence of 35 U.S.C. §103 requires for a determination of nonobviousness that: (1) the scope and content of the prior art be determined, (2) the differences between the prior art and the claims be ascertained, and (3) the level of ordinary skill in the art be considered. The Federal Circuit has added evidence of “secondary considerations” as a fourth factual inquiry when determining nonobviousness.

See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 37 USPQ 2d 1314 (C.A.F.C. 1996); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 2d 1434 (C.A.F.C.) cert denied, 488 U.S. 825 (1988).

When judging whether the differences between the claimed subject matter and the prior art impart the quality of nonobviousness to the subject matter claimed, there are some important cautions and caveats to keep in mind.

First, 35 U.S.C. §103 requires that obviousness be determined by considering “the subject matter as a whole.” The novelty of an invention may turn solely upon whether there is any physical difference between what is claimed and the prior art, i.e., whether there exists any structural difference. By contrast, the obviousness or nonobviousness of a novel structure requires a consideration not only of physical or structural difference, but also a consideration of any differences in effect or function. The Examiner has already acknowledged that the Applicants’ claimed invention is novel by not rejecting the claims under 35 U.S.C. §102.

Also, when applying Section 103, the references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention. As the Federal Circuit has stated, a “[d]etermination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall*, 48 USPQ2d 1319, 1329 (Fed. Cir. 1998). This caveat is especially important in cases like the present invention wherein the subject matter is not technically complex. “Good ideas may well appear ‘obvious’ after they have been disclosed, despite having been previously unrecognized.” *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed Cir. 1997).

It is initially the Examiner's burden to establish a *prima facie* case of obviousness under 35 U.S.C. §103. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more, the applicant is entitled to a grant of a patent.

In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, (Fed. Cir. 1992). To satisfy the Examiner's burden under §103, the Examiner must show some objective teaching in the prior art that would lead one skilled in the art to combine the relevant teachings of the references. *Tec Air, Inc. v. Denso Manufacturing Michigan*, 192 F.3d 1353, 52 USPQ 2d 1294 (Fed. Cir. 1999); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988). The absence of a suggestion to combine is dispositive in an obviousness determination.

Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997). In many of the rejections discussed below, the Examiner fails to set forth a *prima facie* case of obviousness. Even without a discussion of the merits of the claims and the teachings of the prior art, these rejections are facially improper and should not be upheld.

Claims 1, 4-6, 10 and 12-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matthews (5,600,368).

Matthews teaches interactive viewer control of camera viewpoints placed in multiple positions in a sporting contest. For example, in a baseball game, figure 2 and table 1 of Matthews show cameras aimed at center field, first base, the first baseline, the third baseline, third base and home plate. All of the cameras are aimed at a player position or field area. The viewer must constantly switch camera position channels in order to follow a contest. (see Matthews, col. 4, lines 50-62) Matthews also discloses a

directional keypad on a remote control handset which the viewer uses for switching between the different camera viewpoints.

Claim 1 specifically recites a “racing event”. A racing event is the best example of the different function and result of the Applicant’s method. Each car or driver helmet is equipped with a camera. Instead of looking at the field position or player such as in Matthews, the Applicant’s method allows a viewer to watch the race from the perspective of the participant. In effect, rather than looking at someone, the Applicant’s method allows a viewer to look through their eyes.

The Examiner takes the position that the only difference between the claimed invention and the prior art is a mere change in camera angle. The Applicant respectfully disagrees with this assertion. As stated above, the claimed invention and prior art references must each be viewed as a whole. The Federal Circuit has stated that it is error to focus solely on the “differences” between the claimed subject matter and the prior art since the differences may be slight, and yet, constitute the key to success. *Datascope Corp. v. SMEC, Inc.*, 227 USPQ 838 (Fed. Cir. 1985). And even if the only technical difference between Matthews and the prior art happens to be the camera angle, the claim may still be patentable if the function and result are such that the invention is nonobvious. In the present case, the Applicants argue that the result and function of claim 1 are patentably distinct from the disclosure in the prior art references. Instead of focusing on the camera angle, the entire package of benefits and properties must be considered together when determining patentability.

The Applicant’s method as recited in claim 1 would allow each of the fans to view the entire race from the perspective of each fan’s driver of interest. By analogy, in

the method of Matthews, the fan would view a race through a camera positioned in a stationary position on the racetrack and would only be allowed to see his or her driver for a brief instant of each lap. Or, if a viewer wanted to watch his driver for the entire race, the viewer would have to constantly switch cameras, as disclosed by Matthews. The primary interest of the viewer is not to view the various positions of the track or to quickly manipulate a remote handset in order to view a particular car, but rather to see the entire race from the standpoint of the driver himself. Matthews fails to give a plurality of viewers the ability to see or hear what live participants of the viewers' particular interest are seeing or hearing.

The Applicant's method is able to capture the excitement of a live racing event and is an entirely different experience than that of Matthews and the other cited art. Rather than switching from camera to camera to view the sporting action, as required by Matthews, the Applicant's method allows each viewer to see and hear the action in the same manner as a participant does. The viewers virtually ride with the driver, experiencing the track conditions and the positioning of the driver's vehicle in relation to the competitors. The viewers are able to experience firsthand the excitement of events impacting the driver.

As stated above, secondary considerations should also be considered when determining patentability under Section 103. The long-felt need and improved results of the claimed invention are considerations that weigh in favor of nonobviousness. The Examiner acknowledges in page 4 of the Office Action that the claimed invention would provide "an amazing and thrilling experience for race car audiences." The Applicant would argue that providing amazing and thrilling experience is the eternal quest of all

entertainment providers, including NASCAR, television stations such as Fox that broadcast NASCAR events, and pay-per-view providers. However, a product which utilizes the Applicant's method has never been available to a viewer. Accordingly, these considerations should weigh in favor of a determination of nonobviousness.

Claims 13 and 14 are patentable over Matthews for the reasons stated above.

In reference to claim 4, the Examiner acknowledges that Matthews does not teach the transmission of video information via the internet. Instead, the Examiner states that "it would have been obvious to one of ordinary skill in the art to use the Internet for conveniently viewing video information on a computer when one does not have a television available." (Office Action, September 12, 2000). The Examiner fails to provide a motivation for modifying the primary reference, Matthews, to result in the method recited by claim 4, and thus, fails to set forth a *prima facie* case of obviousness. Claim 4 recites that the information regarding the video images are transmitted by way of the internet. Even assuming that the Examiner is implicitly proposing "convenience" as a motivation to modify, the Examiner only proposes such a modification for viewing the images, not for transmitting the images. Accordingly, the rejection is improper and should not be upheld.

In reference to claims 5, 6, 10 and 12, the Examiner cites Matthews as disclosing that a "camera feed is generated for all participants ... and that the images selected by the viewer can be viewed on a display monitor screen." This is the only comment on the rejection of these claims made by the Examiner.

Specifically, claim 5 recites that "a plurality of resulting images are viewed on a split television or monitor screen." Matthews fails to teach this feature, and furthermore,

the Examiner fails to explain his reasoning of how it does teach this feature or can be modified to teach this feature. Accordingly, the Examiner fails to set forth a *prima facie* case of obviousness.

Claim 6 recites that a “split television or monitor screen shows a combination of video images from a camera associated with a participant of particular interest to the viewer, on the one hand, and a standard viewing program of the sporting event on the other.” Matthews fails to teach this feature, and furthermore, the Examiner fails to explain his reasoning of how it does teach this feature or can be modified to teach this feature. Accordingly, the Examiner fails to set forth a *prima facie* case of obviousness.

Claim 10 recites that “camera feed is generated for all participants in the sporting event.” Matthews fails to teach this feature. Although Fig. 2 of Matthews shows a plurality of cameras, it does not show a camera for each player, and thus, a camera feed is not generated for all participants. The Examiner fails to suggest a modification or a motivation to modify Matthews such that it does. Accordingly, the Examiner fails to set forth a *prima facie* case of obviousness.

Claim 12 recites that “a viewer selects camera feed relating to a group of participants, wherein the group consists of participants of a particular team or participants that are predicted winners of the event.” Matthews fails to teach this feature, and furthermore, the Examiner fails to explain his reasoning of how it does teach this feature or can be modified to result in this feature. Accordingly, the Examiner fails to set forth a *prima facie* case of obviousness.

In each of the rejections of claims 5, 6, 10, and 12, the Examiner fails to even allege that Matthews teaches each of the features. The Examiner also fails to allege an

explanation or motivation of how to modify Matthews to result in the features. The rejections are therefore facially improper and should not be upheld.

Claims 2, 3, and 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matthews in view of Vancelette.

Like Matthews, the teachings of Vancelette are patentably distinct from the Applicant's invention. Vancelette teaches a system that allows a television viewer to select specific camera angles and audio feeds of an event which is broadcast by a programming service provider. Vancelette fails to teach a method that allows a viewer to see and hear the action of a sports entertainment program from the perspective of the participant. Thus, even if the references were combined, the results would not yield the Applicant's invention.

In reference to claim 2, the Examiner states in the Office Action that "Vancelette teaches that the viewer can listen to an audio feed of the sporting event's participants." Specifically, Vancelette actually teaches: "a viewer may not want to hear the announcer at all, but may wish to listen to a field level audio feed." (col. 5, lines 42-47) The Examiner, in the Final Office Action, argues that "field level audio feed" can be broadly interpreted as listening to an audio feed of the sporting event's participants. The Applicant disagrees and reads this statement as teaching the sideline listening devices currently used by the broadcasters of sports such as football. Vancelette fails to teach or suggest equipping each participant with his or her own microphone or camera.

Claim 3 recites the use of a pay-per-view system and is patentable for the reasons given above in regard to claim 1.

Claims 7 and 8 relate to providing advertising content and information about the sporting event or the participant with the video information. The Examiner cites Vancelette for teaching this feature, and states “note the term ‘marketing scheme’ implies advertisement.” (Office Action, September 12, 2000). The Examiner is taking this term out of context. The applicable portion of Vancelette states: “Additionally, the head end operator has the opportunity to group particular audio and video signals from the packetized data stream according to a tiered marketing scheme.” In this context, “marketing scheme” refers to the grouping of programming, similar to a pay-per-view or premium movie channel system. In fact, the Examiner implicitly acknowledges such an interpretation by citing the same section of Vancelette as teaching the pay-per-view system of claim 3. In this context, “marketing scheme” has nothing to do with interspersing advertising into a broadcast and should not be cited as such.

In reference to claim 9, the present invention allows the provider of the video images to keep track of viewers’ requests for a particular camera feed as a function of the participants of interest, and this in turn allows a more effective way to compensate participants and price advertising opportunities. The Examiner cites Vancelette as teaching “the use of a rating scheme for gathering statistics on what most people watch and which camera feed is the most common (col. 7, lines 65-67), and essentially gathering ratings is equivalent to gathering viewer’s requests.” Vancellette does indeed recite a “rating scheme.” However, the term in Vancelette is used in a different context from a ratings scheme that gathers viewer’s requests or statistics. The Examiner is impermissibly taking the term out of this context. Vancelette actually recites “The audio/video may also be grouped according to a rating scheme based on, e.g., adult

content, violence or the like.” (Col. 7, lines 65-67). Thus, Vancelette is referring to a rating scheme used to rate the audio or video content of a movie, e.g. X, R, PG, PG-13, or G. This interpretation is supported by other statements in Vancelette. For example, the Examiner argues in his rejection of claim 3 that the portion immediately preceding above-cited statement references a scheme wherein the level of service access is determined by the level of fees paid, i.e., a “pay-per-view” system. Thus, Vancelette teaches that the “rating scheme” provides an alternate way of grouping programming such that a service is provided that will or will not show adult content, violence, etc. As another example, Vancelette cites the availability of the selection of plot lines, characters, and customized programming as an advantage of the described system. (see col. 5, lines 48-56) This option would be consistent with a system grouped by adult content or levels of violence. A service provider could provide as “R” version of a movie or a “PG” version of a movie. Therefore, it is clear that the “rating scheme” in Vancelette refers to a method of “rating” the adult or violence content of a particular group of programming, but has nothing to do with gauging and tracking viewer interest.

When responding to these arguments in his Final Office Action, the Examiner asserted that Vancelette’s “rating scheme” can be “broadly interpreted as tracking viewer’s requesting for camera feed.” Applicant disagrees. As discussed above, the disclosure of Vancelette simply cannot support this proposed interpretation of “rating scheme.” Accordingly, Vancelette fails to teach the tracking feature recited in claim 9.

Even if, assuming for the sake of argument, that “ratings scheme” can be interpreted as tracking viewers request, the Examiner fails to provide a teaching for the remaining portion of claim 9. The Examiner fails to allege that the “ratings scheme” of

Vancelette can be used “to help satisfy viewer interest, compensate participants, and price advertising opportunities.” In order to establish *prima facie* obviousness, each and every limitation of the claims must be taught or suggested by the prior art. See MPEP §§ 2143, 2143, 2143.03.

Further, there is no express or implied motivation provided in the prior art to achieve this aspect of the claimed invention as recited in claim 9. In Matthews, for example, viewers’ selections of portions of a playing field does not permit an effective means for allocating interest to particular participants since Matthews provides no means for determining who, among a plurality of participants, is present in the selected portion or for tabulating the amounts of time the viewers chose to watch respective participants.

Claim 11 recites that “the select group is determined by the number of viewer requests for feed cameras associated with participants.” As discussed above, the Applicant argues that the “ratings scheme” of Vancelette does not teach the feature for which it is cited for. Furthermore, even if, assuming for the sake of argument, that “ratings scheme” can be interpreted as tracking viewers request, the Examiner fails to provide a teaching for the remaining portions of claim 11. The Examiner fails to allege that the “ratings scheme” of Vancelette can be used to generate a feed for a select group of participants which is determined by the number of viewer requests. In order to establish *prima facie* obviousness, each and every limitation of the claims must be taught or suggested by the prior art. See MPEP §§ 2143, 2143, 2143.03.

Accordingly, since the Examiner fails to set forth a *prima facie* case of nonobviousness, the rejections of these claims are facially improper and should not be upheld.

(9) CONCLUSION

For the foregoing reasons, it is respectfully submitted that claims 1, 4-6, 10 and 12-14 are patentable over Matthews, and claims 2, 3, and 7-9 are patentable over Matthews in view of Vancelette. Accordingly, the Examiner's rejection of these claims should be reversed.

The \$155.00 fee for submission of an Appeal Brief and the \$55.00 fee for a one-month extension of time are being submitted herewith. Should the remittance be missing or should any additional fees be required, the Commission may charge the appropriate amount to our Deposit Account No. 22-0261 and notify the undersigned accordingly.

Respectfully submitted,



Chad C. Anderson
Registration No. 44,505
Clifton McCann
Registration No. 29,565
VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 962-4800
Telefax: (202) 962-8300

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APPENDIX

1. A method for distributing video images of a racing event comprising the steps of
 - providing each of a plurality of participants in said event with a video camera,
 - providing each of said cameras with a respective transmitter for transmitting information regarding video images generated by the camera,
 - providing retransmission equipment for receiving information transmitted by the transmitter and directing information regarding video images from each of the plurality of cameras to respective channels for remote viewing at viewers' locations,
 - providing channel selectors that permit viewers to select from among the channels,
 - simultaneously operating said cameras during the event so as to generate a plurality of camera feeds during the event, each feed reflecting a perspective of a respective participant,
 - transmitting the plurality of feeds to the retransmitting equipment, and
 - retransmitting the feeds to said channels, such that each of a plurality of viewers is allowed to select from a plurality of said channels to thus enable viewing of the event through the perspective of one or more participants of greatest interest to the particular viewer.
2. The method of claim 1 in which the video cameras are provided with microphones and provide audio information that accompanies the video image information and is selectively receivable by viewers.

3. The method of claim 1 wherein the information regarding video images is transmitted by way of a pay-per-view television system, wherein the viewer selects video images of interest by selecting a particular pay-per-view channel.

4. The method of claim 1 wherein the information regarding the video images is transmitted by way of the Internet and the viewer selected video images of interest by operating keys or a mouse of a computer.

5. The method of claim 1 wherein viewers select camera feed from a camera associated with a participant of particular interest or a combination of camera feeds from cameras of a plurality of participants or particular interest, wherein a plurality of resulting images are viewed on a split television or monitor screen.

6. The method of claim 1 wherein a split television or monitor screen shows a combination of video images from a camera associated with a participant of particular interest to the viewer, on the one hand, and a standard viewing program of the sporting event on the other.

7. The method of claim 1 in which a provider of the images adds advertising to the video information such that the viewer views advertising information along with images of the sporting event.

8. The method of claim 7 wherein the provider intersperses information about the sporting event or the participant within the advertising information.

9. The method of claim 7 wherein the provider keeps track of viewers' requests for camera feed of the sporting event as a function of the participants of interest and uses the resulting information to help satisfy viewer interest, compensate participants, and price advertising opportunities.

10. The method of claim 1 in which camera feed is generated for all participants in the sporting event.

11. The method of claim 1 in which camera feed is generated for a select group of participants in the sporting event, wherein the select group is determined by the number of viewer requests for feed cameras associated with the participants.

12. The method of claim 1 in which a viewer selects camera feed relating to a group of participants, wherein the group consists of participants of a particular team or participants that are predicted winners of the event.

13. The method of claim 1 wherein the sporting event is a race car competition.

14. A system for distributing sports entertainment comprising a plurality of video cameras mounted on participants in sporting events, a plurality of respective transmitters for transmitting information regarding video images from the plurality of cameras, retransmission equipment for receiving information from said transmitters and directing information regarding the video images to respective channels for remote viewing at viewers' locations, and channel selectors that permit viewers to select from among the channels, thereby allowing the viewers to select and view video images from at least one of said cameras.